

REMARKS

Claims 1-28 are pending in this application. Claims 1 and 15 are independent.

35 U.S.C. § 103

The examiner has rejected claims 1-28 under 35 U.S.C. §103(a) as being unpatentable over an IEEE article entitled "Software Life Cycle Processes" (hereinafter IEEE) in view of one or more of "Windows DNA for Financial Services" (hereinafter Microsoft) and/or "Project Management, A Systems Approach to Planning, Scheduling, and Controlling" by Harold Kerzner (hereinafter Kerzner).

The examiner states:

"Applicant's claims recite elements of "straight through" processing of securities transaction. This limitation is addressed in the rejections below. However a careful reading of the claimed invention shows that the invention is primarily drawn to areas of project management and system optimization."

The applicant's disagree, as indicated by the preamble of the claim and the claim limitations, claim 1 is directed to a method of "assessing the ability of a system to apply straight through processing to securities transactions" not simply to project management and system optimization. Applicants have amended claim 1 to further clarify the straight through processing aspect of the claimed invention.

The IEEE article is related to software life cycle processes in general. The IEEE article does not provide guidance regarding how such general processes could be applied to the problem of "assessing the ability of a system to apply straight through processing to securities transactions." As IEEE admits "this international standard describes the architecture of the software life cycle processes but does not specify the details of how to implement or perform the activities and tasks included in the process."¹ As such, the IEEE article fails to disclose or suggest how such a general software life cycle process could be applied to the problem of

¹ IEEE, page 2

“assessing the ability of a system to apply straight through processing to securities transactions” as recited in claim 1.

The examiner appears to concede that the IEEE article fails to disclose a method for assessing the ability of a system to apply straight through processing to securities transactions. The examiner states that the IEEE article “does not specifically disclose that the project to be analyzed and managed is related to straight through processing of securities transactions.”² While the Microsoft article does identify the straight through processing as “a problem facing the securities industry,”³ the Microsoft article does not disclose or suggest a concrete method for assessing the ability of a system to apply straight through processing to securities transactions. Thus, Microsoft does not add any teachings that cure the deficiencies in IEEE.

Accordingly, whether taken alone or in combination with Microsoft, the IEEE article fails to disclose or suggest “identifying one or more assessment issues, the one or more assessment issues relating to automated processing of securities management functions in the system for processing securities transactions... capturing process and technology performance information relating to a current state of the system for processing securities transactions... analyzing the process and technology performance information with respect to the one or more assessment issues based on a future state for the system for processing securities transactions... capturing information regarding the ability of at least one system external to the system to apply automated straight through processing to securities transactions... storing, on a computer readable medium, the information regarding the abilities of at least one system external to the system to apply straight through processing to securities transactions, formulating at least one recommendation for improving process and technology performance for the system for processing securities transactions.”

§103 - Motivation to combine

The rejection of claim 1 is a hindsight reconstruction, using applicant's claim as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior

² Office Action, page 3

³ Microsoft, page 20

art. This is impermissible under the law. For example, in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In *re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

The present rejection fits the court's description of what may not be done under § 103. The examiner has merely listed certain components of applicant's invention and then located isolated disclosures of those components. The law requires more than that.

The examiner must show where the prior art provides a motivation to combine the references he/she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

The examiner has not shown where the prior art provides a motivation to combine the references. Instead, the examiner merely states that

"it would have been obvious to modify the teachings of 12207 to optimize the straight through processing of securities transactions of Microsoft because this would facilitate the development of a system which would efficiently implement the desired goal of expeditious securities transaction processing."

According to Microsoft "Windows DNAfs for Securities will provide an orderly programming model for interfacing with... industry standards."⁴ Since the Microsoft system purports to provide a solution to the problem of straight through processing, it is unclear how/why one of ordinary skill in the art would desire to modify the system in Microsoft. Even if a person skilled

⁴ Microsoft, page 20

in the art were somehow motivated to modify Microsoft, that person would not have considered the IEEE article because the IEEE article is directed to the general software development process and not to system assessment and development for straight through processing of securities transactions. Further, even if a person skilled in the art had considered trying to modify Microsoft with the IEEE article, the result would not be the method of assessing the ability of a system to apply straight through processing to securities transactions covered by the applicant's claims. Applicants therefore request reconsideration and withdrawal of the rejection of claim 1.

Claim 15 relates to a computer assisted diagnostic system for assessing the readiness of a system for adopting a straight through processing trading environment. The system includes a straight through processing data tool program that includes a plurality of self-contained windows. Each self-contained window is associated with one of a plurality of straight through processing readiness assessment steps.

In rejecting claim 15, the examiner stated, "as to claims 15-18 and 25-26, see discussion above." The examiner fails to address each of the limitations of claim 15 in this rejection. Specifically, the examiner fails to provide support for his position that IEEE and/or Microsoft teaches "an initial form having an activatable command button wherein online user documentation is displayed upon activation, an activatable command button wherein a listing accessing background information documents are presented upon activation, an activatable command button wherein execution of a straight through processing data tool program is initiated upon activation, and an activatable command button wherein the initial form is exited upon activation, online user documentation accessible through the initial programmable form, one or more background information documents accessible through the initial programmable form, [and] a straight through processing data tool program comprising plurality of self-contained windows, wherein each self-contained window is associated with one of a plurality of straight through processing readiness assessment steps, wherein a straight through processing step may include one or more substeps." If this rejection is to be maintained, the applicant requests that the examiner provide documentary support for the rejection.

Dependent claims 2-14 and 16-28 should be patentable for at least the same reasons as the independent claims on which they depend.

Interview

The applicant has amended claim 1 as discussed in the interview with the examiner on April 17, 2006.

The interview included a discussion of the distinctions of the claimed invention compared with the Microsoft and IEEE references.

The applicant asks that all claims be allowed.

Summary

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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Please apply any charges or credits to deposit account 06-1050, reference 12587-064001

Respectfully submitted,

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